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Paul J. Flanningan

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/719,959
Filing Date: November 21, 2003
Appellant(s): FLANNINGAN ET AL.

Karl G. Hanson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on February 26th, 2008 appealing from the Office action mailed on August 22nd, 2007.

(1) *Real Party in Interest*

A statement identifying the real party interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal that is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments*

No amendment after final has been filed.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be reviewed on Appeal*

The first ground of rejection set forth in the appeal brief is incorrect. In the appeal brief; the appellant's first ground of rejection states that claims 1-26 have been rejected under 35 USC §132(a) for claiming subject matter that involves new matter. The examiner would like to point that on the final rejection dated August 22nd, 2007 the examiner objected to the disclosure (*specification*) for introducing new matter not claims 1-26 as stated by the applicant. Furthermore, this issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) *Claims Appendix*

The appealed claims in the appendix of the brief are correct.

(8) *Evidence relied upon*

6,298,849 Scholey et al. 10-2001

(9) *Grounds of Rejection*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-4, 13, 14, 16-19 and 21-26** are rejected under 35 U.S.C. 102(b) as being anticipated by Scholey et al. (US 6,298,849).

As to claim 1, Scholey teaches a respirator mask with snap in filter cartridge that comprises providing at least one supporting portion **22** of a face-piece insert **12** (see **figure 1 and column 2 lines 40-50**); providing at least one fluid communication component **24** (see **figure 1A**) separately from the supporting portion of the face-piece insert; and securing the at least one fluid communication component to the at least one supporting portion (see **figure 3**).

As to claim 2, Scholey teaches a method step of securing a compliant face-contacting member **18** to the face-piece insert (see **column 2 lines 40-50**).

As to claim 3, Scholey teaches a method step of securing a harness to the mask body (see **column 2 lines 35-45**).

As to claim 4, Scholey teaches a method step of providing at least one filter cartridge **32** that is capable of being attached to the at least one fluid communication component (**see figure 1A**).

As to claim 13, Scholey teaches a respirator mask with snap in filter cartridge that comprises a supporting portion **22** (**see figure 1**); and a fluid communication component **24** (**see figure 1A**) that is non-integrally joined to the supporting portion.

As to claim 14, Scholey teaches a respirator mask with snap in filter cartridge that comprises a compliant face contacting member **18** that is non-integrally joined to the supporting portion of the face-piece insert (**see figure 2**).

As to claim 16, Scholey teaches a respirator mask with snap in filter cartridge that comprises a harness for supporting the mask body over a person's nose and mouth (**see figure 1**).

As to claim 17, Scholey teaches a respirator mask with snap in filter cartridge that comprises a filter cartridge **32** for supporting the mask body over a person's nose and mouth.

As to claims 18 and 19, Scholey teaches a respirator mask with snap in filter cartridge wherein the fluid component comprises part of an inhalation valve/exhalation valve (**see figure 1**).

As to claim 21, Scholey teaches a respirator mask with snap in filter cartridge wherein the supporting portion and the fluid communication component are fused together (**see figures 1 and 1A**).

As to claim 22, Scholey teaches a respirator mask with snap in filter cartridge that comprises a mask body **10** (**see figure 1**) that includes a face-piece insert **12** that includes a supporting portion **22**; at least one fluid communication component **24** that is non-integrally

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joined to the supporting portion **22** of the face-piece insert; and a harness for supporting the mask body at least over a person's nose and mouth (**see figures 1, 1A and 2**).

As to claim 23, Scholey teaches a respirator mask with snap in filter cartridge that comprises at least one filter cartridge **32** that is secured to the mask body at a location where the fluid communication component resides (**see figure 1A**).

As to claims 24-26, Scholey teaches a method step wherein the fluid communication component includes a means for allowing a filter cartridge to be attached thereto (**see figure 1c**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **5-12, 15 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholey et al. (US 6,298,849).

As to claim 8, Scholey substantially discloses the claimed invention, see rejection of claim 1 above, but does not disclose that at least one supporting portion of the face-piece insert

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and the at least one fluid communication component are made from similar polymeric materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scholey's invention by providing at least one supporting portion of the face-piece insert and the at least one fluid communication component are made from similar polymeric materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 5-7, 9-12, 15 and 20, close reading of the applicant's specification (see page 2 lines 25 and 26) reveals that these components have always been close tolerance or critical elements therefore applicant's designation of critical elements does not carry any patentable weight.

(10) Response to Argument

As stated above, the first ground of rejection set forth in the appeal brief is incorrect. In the appeal brief, the appellant's first ground of rejection states that claims 1-26 have been rejected under 35 USC §132(a) for claiming subject matter that involves new matter. The new matter being a phrase "**means that is not part of a filter cartridge**" that defines a "fluid communication component (see pages 7 and 10 of the appeal brief). The examiner would like to point out that on the final rejection dated August 22nd, 2007 the examiner objected to the disclosure (*specification*) for introducing new matter not claims 1-26 as stated by the applicant. Furthermore, this issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. The appellant's arguments in

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reference to the amended definition in the disclosure (**specification**) should not be considered since the issue relates to petitionable subject matter.

Before addressing the appellant's second and third arguments, the examiner would like to make it clear that since the amended definition is a petitionable subject matter, the Board should consider the original definition of "fluid communication component" which is defined as "an element that is structured to allow a fluid to pass from an interior gas space to an exterior gas space or vice versa", when reviewing the current application. When considering the original definition of "fluid communication component" the filter cartridge 24 of the Scholey reference allow a fluid to pass from an interior gas space to an exterior gas space or vice versa and therefore is defined as a "fluid communication component".

In reference to the appellant's second ground of rejection, the appellant argues that Scholey does not describe the steps of providing at least one fluid communication component separately from the supporting portion of the face piece insert. The examiner disagrees. The filter cartridge 24 of the Scholey is defined as the fluid communication component and is separately from the supporting portion 22 of the face piece insert 12 (**see col. 2 lines 48-60**).

In reference to appellant's third ground of rejection, the appellant argues that the Scholey reference fails to suggest a fluid communication component that is secured to the supporting portion of a face piece insert. The examiner disagrees with the appellant's arguments. As stated above when using the original definition of the "fluid communication component", the filter cartridge of Scholey is defined as the "fluid communication component and it is secured to to the supporting portion 22 of a face piece insert 12 (**see col. 2 lines 48-60**).

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Nihir Patel/

Examiner, Art Unit 3772

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767

/Marc Jimenez/

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